

REMARKS

Restriction Requirement

In the Office Action of June 26, 2007, the Examiner asserts, on page 2 of the restriction requirement, that the present application contains claims directed to 5 distinct species, Species I (Figure 17), Species II (Figure 19), Species III (Figure 20), Species IV (Figure 21) and Species V (Figure 5). The Examiner asserts further that under Species V there are two sets of subspecies – one set drawn toward the transmitter side and the second toward the receiver side. The Examiner also states the “If” the following subspecies are subspecies of the above Species I – IV, then the Applicants should elect the subspecies as well.

Requirement to state reason for restriction

35 USC §121 specifies that the USPTO “may require the application to be restricted to one of the inventions” if “two or more independent and distinct inventions are claimed in one application.” Guidance as to what constitutes and how to respond to independent and distinct inventions is provided the Examiner in the Manual of Patent Examining Procedure (MPEP).

The Examiner is respectfully reminded that --

“Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why each invention *as claimed* is either independent or distinct from the other(s); and (B) the reasons why there would be a serious burden on the examiner if restriction is not required, i.e., the reasons for insisting upon restriction therebetween as set forth in the following sections.” [MPEP 808; *see also* MPEP 808.01 and 808.02].

This requirement is reiterated at MPEP 808.01, as follows:

“The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

.....

Each relationship of claimed inventions should be similarly treated and the reasons for the conclusions of distinctness or independence set forth. Form paragraph[] 8.01 ... may be used as appropriate to explain why the inventions as claimed are independent or distinct. See MPEP § 806.05 - § 806.06.”

The referenced form paragraph 8.01, Election of Species; Species Claim(s) Present, provides the form by which the Examiner is advised to make a restriction requirement. The first paragraph of this form paragraph 8.01, provides:

"This application contains claims directed to the following patentably distinct species [1]. The species are independent or distinct because [2].

Examiner Note:

2. In bracket 2, explain why the inventions are independent or distinct. ..."

The restriction requirement in the present application includes the first sentence of the first paragraph of form paragraph 8.01. It does not include, however, the second sentence. More importantly, no where in the Office Action of June 26, 2007 is there a statement of the "particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct" as required by MPEP 808.01.

Species I - V

According to the present application, Figure 5 (Species V) is described on page 8 as "a generalized embodiment of a digital burst communication system". (Emphasis added). Figure 19 (Species II) of the present application, as described on page 27, provides "[a] electro-optic optical digital burst system" embodiment of the present invention. (Emphasis added). Figure 20 (Species III), as described on page 28 of the present application, is "[a]nother optical digital burst communication system ... embodiment of the present invention having an optical transmitter ... and the optical receiver ..." (Emphasis added). The present application, at page 29, with respect to Figure 21 (Species IV), states that "[t]his band-tunable digital burst communication system ... comprises an optical/RF transmitter... and an optical/RF receiver ... as shown in FIG. 21." (Emphasis added). Clearly, Figures 19, 20 and 21 (Species II, III and IV) are specific embodiments of the "digital burst communication system" which is generally shown in Figure 5 (Species V).

Figure 17 (Species I), as stated on page 24 of the present application, is provided to show "[a]nother approach for ensuring that the digital receiver maintains sync with the transmitted signal". Significantly, in discussing Figure 17, the present application at lines 7-9 of page 24, when describing the how an RF burst signal is produced in relation to Figure 5. Consequently, Figure 17 (Species I) is also another embodiment of the generalized embodiment of Figure 5 (Species V).

The Applicants cannot, based on the terms of the restriction requirement, determine the basis on which the Examiner finds that embodiments are species of the invention that "patentably distinct" as required by 37 CFR 121. Without the a statement of "particular reasons" for claiming that the species claims are patentably distinct, Applicants are being asked to speculate with respect to responding to the restriction requirement. More importantly, the lack of specificity also makes the election requirement unduly speculative.

Further, the Examiner has not provided the "reasons why there would be a serious burden on the examiner if restriction is not required" as required by MPEP 808. The Examiner is respectfully reminded of MPEP section 803, which states that

"If the search and examination of all the claims in the application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent and distinct inventions."

In the case at issue, Applicant submits that there is no serious burden in examining 85 claims all pertaining to the same technological class 455.

Applicants respectfully request reconsideration of the determination of the finding of species in the present application. If the Examiner persists in finding species within the present application, the Examiner is respectfully requested to comply with MPEP 808 and its subsections to provide the "particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct" and "the reasons why there would be a serious burden on the examiner if restriction is not required".

Subspecies A -G

The Examiner also identifies possible subspecies of the Species I – V. However, the Examiner is not clear as to how or if the subspecies exist. For example, the Examiner, on page 2 of the Office Action, states that "It would appear" that there are subspecies to purported Species V. Further, with respect to Species I – IV, the Examiner states, also on page 2, that "If the following subspecies are subspecies of species I-IV..."

These statements by the Examiner do not provide "particular reasons" as to why the Examiner believes the subspecies to be patentably distinct. Further, since the Examiner has not identified the reasons for determination of the selecting the species, it is axiomatic that the listing of subspecies is speculative. While the subspecies discussion by the Examiner does reference "transmitter side" versus "receiver side," how these distinctions would play within the Examiner's concept of species is simply not provided in the Office Action. In order for the Applicants to properly respond to the restriction requirement, rather than trying to speculate as to what the Examiner's basis for the restriction requirement, the Applicants would need to know the reasons for the requirement.

Further, the Examiner does not provide reasons why the examination of the subspecies would be burdensome. Given that the 85 claims of the present application all pertain to the same technological class 455, there does not appear to be any burden to the Examiner in undertaking an examination of the present application.

Applicants respectfully request reconsideration of the determination of the finding of subspecies in the present application. If the Examiner persists in finding subspecies within the present application, the Examiner is respectfully requested to comply with MPEP 808 and its subsections to provide the "particular reasons relied on by the

examiner for holding that the inventions as claimed are either independent or distinct” and “the reasons why there would be a serious burden on the examiner if restriction is not required”.

Election

Applicants request that the Examiner reconsider the requirement for restriction. Applicants submit that 35 USC §121 authorizes, but does not require, the USPTO to restrict an application to one invention if two or more independent and distinct inventions are claimed in one application. In view of the related filed of technology of all the inventions and in view of the expenses that would be imposed upon the Applicants by multiple applications and multiple patents, it is submitted that restriction requirements should be issued only when absolutely necessary.

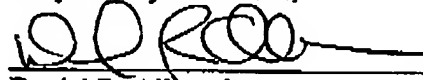
Additionally, Applicants expect the Examiner to use a consistent test with respect to what matters are obvious and what matters are unobvious throughout the prosecution of this application. Because the Examiner is adopting a particular standard for patentability in this case, in terms of the election/restriction requirement, Applicants will expect that the same test be used throughout the prosecution of this application if the Examiner does not withdraw the election/restriction requirement made in the official action.

Therefore, Applicants respectfully request that the Examiner withdraw the restriction requirement. However, as required under 35 USC §121, the Applicants provisionally elect Species V (Claims x-xx).

The traversal of the restriction requirement and the remarks regarding the traversal are being submitted without prejudice. Neither the traversal of the restriction requirement, nor the remarks regarding the traversal shall be interpreted as disputing the Examiner's finding that the Species I - V are patentably distinct.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 50-3984. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.36(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 50-3984.

Respectfully submitted,



Daniel R. Allemeier
Attorney for Applicant
Reg. No. 46,515
HRL Laboratories, LLC
3011 Malibu Canyon Road
Malibu, CA 91302
(310) 317-5851